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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,588	02/09/2001	Richard Levy	01064.0011-07000	6816

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EXAMINER
MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
1714	10

DATE MAILED: 03/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TD-10

Office Action Summary

Application No.	Applicant(s)
09/779,568	LEVY
Examiner	**Group Art Unit**
MEDLEY	1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 11-29-01.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 57-68 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 57-68 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____ .

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____ .

Attachment(s)

☒ Information Disclosure Statement(s), PTO–1449, Paper No(s). 4

☐ Interview Summary, PTO–413

☒ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Patent Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Other _____

Office Action Summary

The finality of Office Action Paper No. 7 dated October 23, 2001 is withdrawn with respect to the rejection of all of the claims under 35 U.S.C. 112, first paragraph, except for claims 61 and 62.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 61 and 62 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The reasons are made of record in Paper No. 7 dated October 23, 2001.

Applicants on page 3 of the appeal brief refer the examiner's attention to the written description, pages 6-9 lubricants, page 12 lubricant on cables, for support page 6, lubricants on wire for support for the instant claimed substrate may also comprise a cable, or wire. However, a carefully study and review of the instant application indicate that the particularly selection description at pages 6-9, 12 and , respectively is admitted prior art as to what is well-known and conventionally used in the lubricant art.

Claims 58, 67 and 68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. The subject matter of claim 58 that the "superabsorbent polymer . . . desorbs water the coating is dried" is not properly described in the application as filed, and consequently raise doubt as to possession of the claimed invention at the time of fling. The examiner's position after a careful review and study of pages 31 and 32 of the instance application is that "the lubricant composition is dried to remove water, substantially all of the water introduced in the first part of the process. This step for drying the lubricant composition appears to be different than instant claim 58 step "for desorbing water when the coating is dried.

The subject matter of claims 67 and 68 that the "coating comprises further a binder" is not properly described in the application as filed, and consequently raise doubt as to possession of the claimed invention at the time of filing. The examiner's position after a careful review and study of pages 17-18 directed to "binder systems" is Admitted Prior Art, as to what is well-known and conventionally used in the lubricant art. The examiner did not find **any explicit** disclosure to any binders at pages 19, 20, and 21 and applicants did not particularly set forth or point out any such paragraph as to the location of said binders.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 58-60 and 66-68 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hopkins 5,362,788 combined with the Merck Index and Admitted Prior Art.

Hopkins teach a process for preparing a composition comprising a matrix of cellulose acetate, glycerine and a superabsorbent polymer, (SAP), e.g. SANWET(R) which is a starched grafted polyacrylate sodium salt that has the capacity to absorb as much as 800 times its own weight in liquid, note Example 1, claims 1-3, abstract, and column 1, line 29 to column 2, lines 1-33. The Merck Index is relied on as a teaching reference that glycerine has lubricant properties and have been conventionally used as a lubricant which inherently reduces friction, note #4347, Glycerol, glycerine, for its use at page 644. Applicant makes admission on record that their superabsorbent polymers are those of Brannon-Peppas, note the paragraph bridging pages 22-23 of the instant application. Brannon-Peppas teaches various known superabsorbent polymers and their chemical and physical properties including the ability to absorb greater than 100 times its weight in water. He also teaches conventional well-known superabsorbent polymers that are commercially available, note particularly page 245. The claims are anticipated by the teachings of Hopkins combined with the teachings of the Merck Index and Admitted Prior Art because lubricants intrinsically function as a coating on a substrate.

Claims 58-68 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Admitted Prior Art.

Applicant make admission on record that prior art, Levy 4,985, 251 combined with Brannon-Peppas, disclosed on pages 24-25 of the instant application, teach and disclose that superabsorbent polymers are their claimed superabsorbent polymers, note Levy '251 at column 18 for Example 1 for teaching to a process for preparing a composition, and a composition

comprising water, SuperSorb(R), a polymer that absorbs greater than 100 times its weight in water and Arosurf(R) MSF, (fatty acid, esters, ethers and alcohols), that functions as a film forming agent, as a surfactant emulsifier, or as an insecticidal, note column 17, lines 42-54. Applicant make admission on record that their superabsorbent polymers are those of Brannon-Peppas, note the paragraph bridging pages 22-23 of the instant application. Brannon-Peppas teaches various known superabsorbent polymers and their chemical and physical properties including the ability to absorb greater than 100 time its weight in water. He also teaches conventionally well-known superabsorbent polymers that are commercially available, note particularly page 245. The composition and process for producing said composition comprising a SAP, water and a film forming additive or surfactant of Levy '251 combined with Brannon-Peppas anticipates the claimed composition and process of making said composition when used as a lubricant composition which would inherently reduce friction because water, a universal well-known lubricant, reduces friction because lubricants intrinsically function as a coating on a substrate.

Claims 57, 61, 62 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Geursen et al WO 93/18223.

In the abstract, Guersen et al teach a coating on a substrate (claim 6 and page 10, line 27 to page 11, line 26), said coating comprising a superabsorbent polymer (page 6) and a lubricant (page 7, lines 20-25) and a process for adding the polymer to the lubricant (page 7, lines 6-11 and Example 1, pages 15-16) which anticipates the instant claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 58-60, 63-64, and 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geursen et al WO 93/18223 as applied to claims 57, 62 and 65 above, and further in view of Geursen et al WO 93/18223 combined with the Admitted Prior Art.

Applicants instant claims further claim superabsorbent polymers absorbing greater than 100 times its weight in water (claims 58, 60, 65 and 67), a viscosity improving agent (claims 59-60, 63-64 and 66) and a binder (claims 67-68) wherein Geursen et al is silent to said additives. It is the examiner's position that the inclusion of a superabsorbent polymer, a viscosity additive and a binder would be obvious in view of the Admitted Prior Art.

Applicants make admission on record at page 17-18 bridging paragraph that binders, and at page 9-10 bridging paragraph, that viscosity improving additives are conventional additives used in conventional lubricant compositions of pages 1-19. Applicants further make admission on record in the instant application at the bridging paragraph of pages 22-24 that prior art Patentees Levy Patents 4,983,389 and 4,985,251; Takeda et al patens 4,525,527; and 4,612,250 Mikita et al patents 4,552,938; 4,618,631; 4,654,393 and 4,703,067; Alexander et al 4,677,174; Brannon-Peppas, Absorbent Polymer Technology, 1990; and Buchholz et al Superabsorbent Polymers, Science and Technology, 1994 ACS teach a number of SAP comprising acrylic acid, an acrylic

ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, that absorbs greater than about 100 times its weight in water. Patentee Levy '251 further teaches compositions and process for making said compositions comprising water. SuperSorb(R) that absorbs greater than 100 times its weight in water and Arosurf(R) MSF (fatty acid esters, ethers and alcohols), that functions as a film forming agent or surfactant or emulsifier or an insecticidal, note column 17, lines 42-54.

Applicant further make admission on record that their superabsorbent polymers are those of Brannon-Peppas, note the paragraph bridging pages 22-23 of the instant application. Brannon-Peppas teaches various known superabsorbent polymers and their chemical and physical properties including the ability to absorb greater than 100 times its weight in water. Patentee also teaches conventional well-known superabsorbent polymers that are commercially available, note particularly page 245. It would have been obvious to the artisan in the art to substitute the SAP of the secondary references for the polymers of the primary reference for the same intended function to absorb greater than 100 times its weight in water. It is the examiner's position of record that lubricants intrinsic function is to lubricant a substrate. Thus in order to function a lubricant, the lubricant composition would have to coat a surface to reduce friction or to lubricate and therefore function as a coating when it contact a substrate.

Claims 57, 59 and 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaa et al 4,810,576 or Cossement et al 5,236,982.

Patentees, Gaa et al, column 4, lines 50-55, column 6, lines 5-60, column 8, lines 12-14, column 10, lines 5-7 and column 11, lines 30-53); and Cossement et al, column 1, lines 44-51 and column 5, lines 20-65, each alone teach fibers reinforcing material comprising coating/sizing compositions, wherein said coating composition comprises an aqueous solution of a base neutralized polyacrylate, and polymeric/binder agents, along with any conventional compounds known to be useful in aqueous compositions for coating such fibrous substrate. It is the position of the examiner that lubricant compositions intrinsically function as a coating when it contacts a surface so that it lubricant properties can be exhibited. Hence the coating composition function as a lubricant.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-43 of copending Application No. 09/357,957. Although the conflicting claims are not identical, they are not patentably distinct from each other because the coating compositions comprising a superabsorbent

polymer, (SAP), a lubricant and further including a viscosity additive or binder are not patentably distinct from the related application lubricant composition comprising a SAP lubricant and other lubricant additives because the claims contain the open-ended language "comprising" and would not exclude the components of the other composition or coating from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 57-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 57-71 of copending Application No. 09/359.809. Although the conflicting claims are not identical, they are not patentably distinct from each other because the coating compositions comprising a SAP, a lubricant and further including a viscosity additive or binder are not patentable distinct form the related application product by process lubricant composition comprising SAP, lubricant and other lubricant additives because the claims contain the open-ended language "comprising" which would not exclude the components of the other composition or coating from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record by applicants have been reviewed in the parent or other related applications.

The prior art made of record and not relied upon further teach coatings and lubricants comprising additives of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Medley:mv

March 25, 2002

Margaret B. Medley

MARGARET MEDLEY
PRIMARY EXAMINER